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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,334	08/08/2001	Adam Robinson	10587-003	1771
20582	7590	12/03/2003	EXAMINER	
PENNIE & EDMONDS LLP 1667 K STREET NW SUITE 1000 WASHINGTON, DC 20006			SAADAT, CAMERON	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,334

Applicant(s)

ROBINSON, ADAM

Examiner

Cameron Saadat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

In response to the request for reconsideration filed 9/15/03, claims 1-51 are pending in this application.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 1-35, and 38-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foltz et al. (USPN 6,356,864; hereinafter Foltz) in view of Driscoll et al. (USPN 5,987,302; hereinafter Driscoll).**

Regarding claims 1, 13, 22, 29, 38, and 47, Foltz discloses a computer-assisted method of evaluating an essay, comprising: receiving an essay concerning an essay topic; electronically comparing textual content of the essay with a first number of terms related to said essay topic; identifying missed terms, the missed terms being those terms which are among said first number of terms, but are not present in the textual content of the essay (column 4, lines 24-32). Although Foltz identifies missed terms it is not explicitly disclosed that the missed terms are *transmitted*. However, the feature of *transmitting* information in the educational arts is well known for providing educational services to multiple users in different locations. Furthermore, Driscoll discloses an essay evaluation system wherein a user's response along with desired responses (feedback) are transmitted to a user (column 12, lines 13-19).

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Hence, in view of Driscoll, it would have been obvious to an artisan to modify the evaluation system described in Foltz, by transmitting the evaluation information of the essay, in order to provide the evaluation system to multiple users at remote locations, thereby minimizing geographical setbacks.

Regarding claims 2-3, 11-12, 16-19, 24-25, 27-28, 31-34, and 40-43, Foltz discloses an essay evaluation system wherein a score and a subscore is generated concerning the essay (column 12, lines 65-67). It is not explicitly stated that Foltz's score concerning an essay (as per claims 2-3, 16-17, 24-25, 31-32, and 40-41) and a comment (as per claims 11-12, 18-19, 27-28, 33-34, 42-43) concerning the essay is **transmitted**. However, Driscoll discloses an essay evaluation system that transmits feedback and performance information including comments via the Internet. Hence, at the time of the invention, in view of Driscoll, it would have been obvious to a person of ordinary skill in the art to modify the evaluation system described in Foltz, by **transmitting** the score information, in order to provide the evaluation system to multiple users at remote locations, thereby minimizing geographical setbacks.

Regarding claims 4-5, Foltz discloses an essay evaluation system that identifies missed terms in an essay. Foltz's system is not explicitly presented over the **Internet** (as per claim 4) or over a **network** (as per claim 5). However, Driscoll discloses an essay evaluation system that is provided over a network or the Internet (column 5, line 2). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the evaluation system described in Foltz, by providing the system over a network or the Internet, in light of the teachings of Driscoll, in order to provide the evaluation system to multiple users at remote locations, thereby minimizing geographical setbacks.

Regarding claims 6 and 7, Foltz discloses an essay evaluation system that identifies missed terms in an essay on a local computer. It is not explicitly stated that feedback information (missed terms) are displayed on a **first computer** and that the evaluation (comparing textual content) is **second computer**. However, the evaluation system disclosed in Driscoll teaches the feature of providing feedback on a user's computer and providing the evaluation on a second computer (column 5, lines 1-19). Hence, at the time of the invention, in view of Driscoll, it would have been obvious to a person of ordinary skill in the art to modify the evaluation system described in Foltz, by providing feedback on a

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user's computer and providing the evaluation on a second computer, in order to provide the evaluation system remotely so that the evaluation of several users may occur at a remote location.

Regarding claims 8-9, 20-21, 26, 35, and 44-45, Foltz discloses an essay evaluation system that provides a user with an essay question. It does not explicitly disclose the option of selection essay topics. However, Driscoll provides a user with the selection of various essay topics (see Fig. 11). At the time of the invention, it would have been obvious to an artisan of ordinary skill to modify the essay evaluation system described in Foltz, by allowing a user to designate an essay topic, in light of the teachings of Driscoll, thereby allowing a user to preview the essay before selecting the essay.

Regarding claim 10, Foltz discloses an essay evaluation system that identifies included terms, the included terms being those terms which are among said first number of terms, and are present in the textual content of the essay (column 4, lines 27-31).

Regarding claim 14, the examiner takes official notice that a hard disk, floppy disk or a CD-ROM are notoriously old and well known forms of computer storage medium. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide any of the aforementioned storage medium for storing software code.

Regarding claims 47-50, Foltz discloses a computer-assisted method of evaluating an essay, comprising: receiving a first essay on an essay question; extracting evaluation information associated with said selected essay question; electronically comparing textual content of said first essay with a first set of terms previously extracted from a model essay; identifying missed terms among said first set, the missed terms being those terms which are not present in the textual content of said first essay; identifying included terms among said first set (column 4, lines 24-32); Although Foltz identifies missed terms and included terms, it is not explicitly disclosed that the missed terms are transmitted. However, it is old and well known to transmit information in the educational arts. Furthermore, Driscoll discloses an essay evaluation system wherein a user's response along with desired responses are transmitted to a user (column 12, lines 13-19). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify essay evaluation system that identifies missed terms described in Foltz

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and transmitting the evaluation results, in light of the teachings of Driscoll, in order to provide the user with comparative feedback regarding his/her performance.

Furthermore, Foltz discloses an essay evaluation system wherein a score and a subscore is generated concerning the essay (column 12, lines 65-67). It is not explicitly stated that Foltz's score concerning an essay and a comment concerning the essay is *transmitted*. However, Driscoll discloses an essay evaluation system that transmits feedback and performance information including comments via the Internet. Hence, at the time of the invention, in view of Driscoll, it would have been obvious to a person of ordinary skill in the art to modify the evaluation system described in Foltz, by transmitting the score information, in order to provide the evaluation system over the Internet so that the evaluation of several users may occur at a remote location thereby requiring the evaluation system to transmit feedback information to the users.

In addition, Foltz discloses an essay evaluation system that provides a user with an essay question. It does not explicitly disclose the option of selection essay topics. However, Driscoll provides a user with the selection of various essay topics (see Fig. 11). At the time of the invention, it would have been obvious to an artisan of ordinary skill to modify the essay evaluation system described in Foltz, by allowing a user to designate an essay topic, in light of the teachings of Driscoll, thereby allowing a user to preview the essay before selecting the essay.

4. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foltz et al. (USPN 6,356,864; hereinafter Foltz) in view of Driscoll et al. (USPN 5,987,302; hereinafter Driscoll), still further in view of Burstein et al. (USPN 6,366,759; hereinafter Burstein).

Foltz and Driscoll disclose an essay evaluation system, yet neither reference explicitly discloses a time period for composing an essay. However, Burstein discloses an essay evaluation system wherein a user is provided a specific time period in which to compose an essay (column 10, line 41). Hence, in view of Burstein, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the essay evaluation system described in the combination of Foltz and Driscoll, by providing a time period to compose an essay, in order to provide a standardized test by allocating a time period to compose an essay, thereby averting an unfair advantage in user performance.

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5. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foltz et al. (USPN 6,356,864; hereinafter Foltz) in view of Driscoll et al. (USPN 5,987,302; hereinafter Driscoll), still further in view of Burstein et al. (USPN 6,366,759; hereinafter Burstein), still further in view of Maron (USPN 4,705,479).

The combination of Foltz, Driscoll and Burstein discloses an essay evaluation system wherein the user is provided with feedback regarding performance in responding to an essay. The references do not explicitly disclose the step of allowing a user to revise an existing essay which was previously submitted for evaluation. However, Maron discloses a computerized question/answer evaluation system wherein the user is provided with the option to revise his/her answer that was already submitted (Column 7, lines 37-41). At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the essay evaluation system as described in the combination of Foltz, Driscoll, and Burstein by allowing a user to revise and resubmit a response to a question, in order to allow a user to attempt an improved response, based on the feedback provided for the previous response, thereby enhancing the learning experience.

6. Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foltz et al. (USPN 6,356,864; hereinafter Foltz) in view of Driscoll et al. (USPN 5,987,302; hereinafter Driscoll), still further in view of Maron (USPN 4,705,479).

The combination of Foltz and Driscoll discloses an essay evaluation system wherein the user is provided with feedback regarding performance in responding to an essay. The references do not explicitly disclose the step of allowing a user to revise an existing essay which was previously submitted for evaluation. However, Maron discloses a computerized question/answer evaluation system wherein the user is provided with the option to revise his/her answer that was already submitted (Column 7, lines 37-41). At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the essay evaluation system as described in the combination of Foltz and Driscoll by allowing a user to revise and resubmit a response to a question, in order to allow a user to attempt an improved response, based on the feedback provided for the previous response, thereby enhancing the learning experience.

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Response to Arguments

7. Applicant's arguments filed 9/15/03 have been fully considered but they are not persuasive.

Applicant asserts that the § 103(a) rejections set forth are not proper because neither Foltz nor Driscoll teach, disclose, or even suggest identifying, transmitting or receiving missed terms.

The standard of patentability is what the prior art, taken as a whole, suggests to an artisan at the time of the invention. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The question is not only what the references expressly teach, but what they would collectively suggest to one of ordinary skill in the art. *In re Simon*, 461 F.2d 1387, 1390, 174 USPQ 114, 116 (CCPA 1972). In this case Foltz discloses an automated grading process for essays, wherein the process includes diagnosing and providing information *indicating* which components (paragraphs or sentences) of a subject matter the essay should or should not contain. Although Foltz identifies missed terms it is not explicitly disclosed that the missed terms are *transmitted*. However, the feature of *transmitting* information in the educational arts is well known for providing educational services to multiple users in different geographical locations. Furthermore, Driscoll discloses an essay evaluation system wherein a user's response along with desired responses (feedback) are transmitted to a user (column 12, lines 13-19). Hence, in view of Driscoll, it would have been obvious to an artisan to modify the evaluation system described in Foltz, by transmitting the evaluation information of the essay, in order to provide the evaluation system to multiple users at remote locations, thereby minimizing geographical setbacks.

Applicant should consider including structural limitations of, the method by which the missed terms are identified, in the claim language to distinguish over the prior art.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action

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is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is 703-305-5490. The examiner can normally be reached on M-F 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

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Teresa Walberg
Supervisory Patent Examiner
Group 3700